REMARKS

Reconsideration and withdrawal of the restriction requirement is respectfully requested in view of the remarks presented herein.

The Examiner has required restriction from among the species directed to the variables in the claims drawn to compounds of Formula I.

1.1

Applicants hereby elect the species directed to the following compound of Formula I with the following R₄ group below, with <u>traverse</u>, for prosecution on the merits.

The MPEP lists two criteria for restriction to be proper. First, the invention must be independent or distinct. MPEP §803. Second, searching the additional invention(s) must constitute an undue burden on the Examiner if restriction is not required. *Id.* The MPEP directs the Examiner to search and examine an entire application "[i]f the search and examination of an entire application can be made without serious burden . . . even though it includes claims to distinct or independent inventions." *Id.*

The claims, as originally filed, provide a unity of invention, which is not atypical for macrocyclic, compound-type patent applications with similar types of claims and is searchable by the Examiner. The Examiner asserts that the compounds claimed in general formula (I) do

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not define a contribution over art cited by the Examiner as prior art, WO/99/021514A2 ("the '514 PCT"). It is our understanding that the '514 PCT includes as principal features the following compound structures:

Even though there are certain structural and use similarities between the compounds in the present application and the '514 PCT, there are structural differences. Elected species with the above R₄ group further differentiates these products. Moreover, there would be no undue burden on the Examiner to search the originally claimed species, despite the certain variables, because a proper search would start with the macrocyclic core structure, not the heterocyclic/cyclic atom molecules attached to the core structure. Enforcing the present restriction requirement would result in inefficiencies and unnecessary expenditures by the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, whereby a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially in view of the requisite showing that a serious burden has not been met. Indeed, the search and examination of each commonly classified species would likely be co-extensive and, in any event, would involve such interrelated art that search and examination of the entire application can be made without undue burden on the Examiner. All of the preceding, therefore, mitigate against restriction.

CONCLUSION

Reconsideration and withdrawal, or modification of the restriction requirement, and a prompt and favorable examination on the merits, is respectfully requested.

Respectfully submitted,

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